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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,452	11/20/2003	Ulrich Sander	33997. 0093 (L 012 P-US)	9827
26712	7590	08/10/2005	EXAMINER	
HODGSON RUSS LLP ONE M & T PLAZA SUITE 2000 BUFFALO, NY 14203-2391			AMARI, ALESSANDRO V	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,452

Applicant(s)

SANDER, ULRICH

Examiner

Alessandro V. Amari

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7 and 9-14 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanzawa US 6,304,374.

In regard to claim 1, Hanzawa teaches (see for example, Fig. 2) a stereomicroscope comprising an objective (2), a zoom system (32, 33) downstream of the objective, and a deflector element (4, 5) between the objective and the zoom system for deflecting observation beams emerging from the objective into corresponding magnification or observation channels of the zoom system; wherein the zoom system includes at least three substantially horizontally extending magnification or observation channels (7L, 7L', 7R, 7R') as described in column 4, lines 17-65.

Regarding claim 2, Hanzawa teaches (see Fig. 2) that the zoom system has four magnification or observation channels (7L, 7L', 7R, 7R') as shown in Figure 2.

Regarding claim 5, Hanzawa teaches (see Figure 3) further comprising another deflector element (11, 12, 13) downstream of the zoom system for deflecting fewer than all of the observation beams received by the another deflector element as described in column 5, lines 3-28.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanzawa US 4,763,968 in view of Kleinberg US 5,052,789.

In regard to claims 6 and 7, Hanzawa teaches the invention as set forth above but in regard to claims 6 and 7, does not teach that the stereomicroscope further comprises a deflector element which is pivotable about a horizontal or vertical axis.

Regarding claims 6 and 7, Kleinberg does teach (see Figures 2, 10) a deflector element (36, 38, 48, 50, 60, 62) which is pivotable about a horizontal or vertical axis as described in column 3, lines 49-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to pivot the deflector element as taught by Kleinberg in the stereomicroscope of Hanzawa in order to allow for angular deviation of the microscope system while maintaining correct image orientation.

5. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanzawa US 4,763,968 in view of Takahama et al US 5,861,982.

Regarding claims 9 and 12, Hanzawa teaches the invention as set forth above but does not teach at least one optical add-on component having a horizontal or vertically extending optical axis or regarding claim 12, an optical splitter.

Regarding claim 9, Takahama et al teaches (see Fig. 8) further comprising at least one optical add-on component having a horizontally or vertically extending axis as described in column 10, lines 44-67 and column 11, lines 1-13. Regarding claim 12, Takahama et al teaches the at least one opto-mechanical component includes a beam splitter as described in column 10, lines 49-53.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the opto-mechanical components as taught by Takahama et al in the stereomicroscope of Hanzawa in order to accurately insert/remove optical components into/from corresponding switching positions without a complicated adjustment as described in column 6, lines 13-18 of Takahama et al.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanzawa US 4,763,968 in view of Takahama et al US 5,861,982 and further in view of Straehle et al US 20030165012.

Regarding claim 10, Hanzawa in view of Takahama et al teaches the invention as set forth above but does not teach an SDI element.

Regarding claim 10, Straehle et al does teach (see Figure 7) an SDI device (750) as described in page 6, paragraph 0063.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the SDI as taught by Straehle et al in the stereomicroscope of Hanzawa in view of Takahama et al in order to provide reversion of the optical image for ease of viewing of the object.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanzawa US 4,448,498 in view of Takahama et al US 5,861,982 and further in view of Simon et al US 6,356,088.

Regarding claim 11, Hanzawa in view of Takahama et al teaches the invention as set forth above but does not teach a laser shutter.

Regarding claim 11, Simon et al teaches a laser shutter as described in column 2, lines 15-33.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a laser shutter as taught by Simon et al in the stereomicroscope of Hanzawa in view of Takahama et al in order to ensure laser safety in the device.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanzawa US 4,448,498 in view of Takahama et al US 5,861,982 and further in view of Shioda et al US 6,081,371.

Regarding claim 13, Hanzawa in view of Takahama et al teaches the invention as set forth above but does not teach a data projecting device.

Regarding claim 13, Shioda et al does teach (see Figures 18, 19) a data projector (126, 127, 129, 130, 131, 132).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the data projector of Shioda et al in the stereomicroscope of Hanzawa in view of Takahama et al in order to observe other data about the specimen in the same visual field as the observed image of the specimen.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanzawa US 4,448,498 in view of Takahama et al US 5,861,982.

Regarding claim 14, Hanzawa in view of Takahama et al teaches the invention as set forth above but does not teach a filter. Official Notice is taken that it is notoriously old and well known in the microscope art to have additional components such as filters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add filters to the stereomicroscope as claimed above in order to provide improved viewing of the specimen under examination.

Allowable Subject Matter

10. Claims 3, 4 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claim 3 is allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest, "the objective has an optical axis extending substantially vertically" as set forth in the claimed combination. Claim 4 is also allowable based upon its dependence on claim 3.

Claim 8 is allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest, "further comprising deflector elements downstream of the zoom system for redirecting the observation beams along a horizontal direction that is substantially opposite to a horizontal direction along which the observation beams travel through the zoom system" as set forth in the claimed combination.

The prior art of record teaches a stereomicroscope comprising an objective, a zoom system downstream of the objective, and a deflector element between the objective and the zoom system for deflecting observation beams emerging from the objective into corresponding magnification or observation channels of the zoom system; wherein the zoom system includes at least three substantially horizontally extending magnification or observation channels. However, the prior art of record does not teach that the objective has an optical axis extending substantially vertically or further comprising deflector elements downstream of the zoom system for redirecting the observation beams along a horizontal direction that is substantially opposite to a horizontal direction along which the observation beams travel through the zoom system and there is no motivation or teaching to modify this difference as derived.

Response to Arguments

12. Applicant's arguments with respect to claims 1, 2, 5-7, and 9-14 have been considered but are moot in view of the new ground(s) of rejection.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ava@14
25 July 2005

Alessandro Amari
Alessandro Amari
Examiner AV 2872